

DISCUSSION OF THE CLAIMS

Claims 93-122 are pending in the present application. Claims 1-92 are canceled claims. Claims 111-122 are new claims. Support for the new claims is found in the previously presented claims.

No new matter is added.

REMARKS

The present claims are drawn to particular processes that require reacting a particular alkylated phenol with an aldehyde and a particular amine (see Claim 93).

The Office takes the position that the presently claimed invention is obvious over a combination of references including Worrel (U.S. 3,948,619), Cherpeck (U.S. 5,300,701) and Baxter (U.S. 6,562,913). The Office concedes that the primary reference, Worrel, does not disclose an alkylated phenol such as a phenol that has been reacted with a polyisobutene having a particular polydispersity property (see page 3, lines 9-11 of the March 30, 2010 Office Action). To cure this deficiency of the Worrel reference the Office relies on Cherpeck.

The Office appears to reach a conclusion of obviousness based on the determination that each of the features of present Claims 93-110 are disclosed in the references. For example the Office asserts that Cherpeck discloses alkylating a phenol with a polyisobutene having molecular weight characteristics that are similar to or encompassed by the molecular weight characteristics of the present claims. The Office further relies on Baxter as evidence that certain polyisobutenes have a polydispersity that is within the polydispersity recited in the present claims.

Arguendo, even if Applicants' invention as embodied in Claims 93-110 includes a combination of conventional chemicals known or described before the filing date of the present application, the Office's rejection of the claims as obvious over the Worrel, Cherpeck and Baxter references improperly relies on hindsight to reach a conclusion of obviousness. Applicants respectfully remind the Office that the hindsight reconstruction of a claimed invention using Applicants' disclosure as a template is impermissible. Applicants draw the Office's attention to M.P.E.P. §2142:

To reach a proper determination under 35 U.S.C. §103, the examiner must step backward in time and into the shoes worn

by the hypothetical “person of ordinary skill in the art” when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention “as a whole” would have been obvious at the time to that person. Knowledge of applicant’s disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the “differences,” conduct the search and evaluate the “subject matter as a whole” of the invention. **The tendency to resort to “hindsight” based on applicant’s disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.**

The impermissible and/or improper use of hindsight as a basis for rejecting a claim as obvious was addressed by the Supreme Court in the landmark decision in *KSR*. The Supreme Court made it clear that hindsight reasoning is an improper basis for rejecting a claim as obvious:

A fact finder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments relying upon *ex post* reasoning. See *Gram*, 383 U.S., at 36 (warning against a “temptation to read into the prior art the teachings of the invention in issue” and instructing courts to “guard against slipping into the use of hindsight” (citations omitted)).

See *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 at 1388 (U.S. 2007).

Here the Office impermissibly used hindsight to reconstruct the claimed invention. Applicants submit that a conclusion that the presently claimed invention is obvious based only upon the disclosure of various features of the claimed invention in a scattering of prior art references is improper.

The claimed invention is drawn to a particular process for forming a particular Mannich adduct. The primary reference relied on by the Office has a publication date in 1976. Had it been obvious to carry out the presently claimed invention surely either Cherpeck (published in 1994) or Baxter (published in 2003) would have recognized the presently claimed invention and either claimed it or described it in a defensive manner.

The fact remains that Baxter and Cherpeck do not describe the presently claimed invention even though these patents had the benefit of the passage of almost twenty years since the publication of the Worrel reference. Applicants submit that this temporal relationship between the respective disclosures of the cited references is probative of the non-obviousness of the presently claimed invention.

Moreover, there is no evidence of record that those of ordinary skill in the art would have been motivated or would have had any expectation of success in combining the features of the present claims allegedly disclosed in the cited references. Just because certain features are described in the prior art does not mean that it would have been obvious to assemble those features in the particular manner described in the present claims.

Applicants thus further respectfully request withdrawal of the rejection.

Applicants draw the Office's attention to new independent Claim 111. The new independent claim describes a process in which a bicyclic Mannich adduct is formed (see formula (Ib)). Applicants submit that new Claim 111 and the claims dependent therefrom are further patentable over the cited references in view of their respective silence with respect to the formation of a particular bicyclic Mannich adduct such as that of formula (Ib).

For the reasons discussed above in detail, Applicants request withdrawal of the rejection and the allowance of all now-pending claims.

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